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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,919	09/11/2003	Ruediger Guenter Kreuter	2968.215USU1	6015
23552	7590	02/15/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			PAIK, STEVE S	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

(52)

## Office Action Summary

Application No.

10/659,919

Applicant(s)

KREUTER, RUEDIGER GUENTE

Examiner

Steven S. Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/15/03; 5/10/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of claiming the benefit under 35 U.S.C. 119(e) of United States provisional application, 60/412,267 filed on September 20, 2002.

### ***Claim Objections***

2. Claims 15 and 17 are objected to because of the following informalities: the word, "it" in line 6 and 4 of claims 15 and 17 respectively would be more precisely recite the claimed invention by replacing the word with -- said personalization unit --. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5-9, and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al. (US 6,588,673).

Re claims 1 and 8, Chan et al. disclose a system and a method for providing personalization solutions for smart cards (identity documents) comprising:

a portable personalization machine (smart card personalization system 130 or 300) that includes at least one personalization unit (personalization equipment 136 or 330) for performing a personalization operation (such as printing or embossing data on the surface of the card,

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encoding the magnetic strip on the card, and programming cardholder data into microcontroller chip of the card) on an identity document (smart card 10), an input for inputting (keyboard or magnetic tape reader, floppy disk drive, CD-ROM, or on-line connection through the Internet, a dedicated line, a cable, or satellite signal) an identity document to be personalized, an output (card printer) for outputting an identity document personalized by the personalization unit, a control unit (CPU of a PC) controlling the personalization unit (136 or 330), communications equipment (modems/cable modems) to permit communications with a controlling authority (card issuer system 112) remote (Fig. 2c or 3) from the personalization machine, and an interface (HSM 114, 124, and 134 connected within a network) to permit connection to a local controller;

a controlling authority (card issuer system 112) remote from the personalization machine (smart card personalization system 130 or 300); and

a local controller (CPU of a PC) that is interfaceable with the interface of the personalization machine (Fig. 2c or 3).

Re claims 2 and 9, Chan et al. disclose the system and method as recited in rejected claims 1 and 8 stated above, wherein the personalization machine further includes an encryption unit for encrypting and decrying communications between the communications equipment of the personalization machine and the controlling authority (col. 4, ll. 28-48 and col. 8, ll. 18-58).

Re claims 5 and 12, Chan et al. disclose the system and method as recited in rejected claims 1 and 8 stated above, wherein the interface comprises an Ethernet connection (col. 9, ll. 51+)

Re claims 6 and 13, Chan et al. disclose the system and method as recited in rejected claims 1 and 8 stated above, wherein the personalization unit comprises a laser engraving unit,

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an ink-jet printer, or an integrated circuit chip programming unit (col. 3, ll. 12-23 and col. 8, ll. 50-58).

Re claims 7 and 14, Chan et al. disclose the system and method as recited in rejected claims 1 and 8 stated above, wherein the personalization unit is adapted to personalize cards (smart cards 10) or booklets.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 10, 11, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US 6,588,673) in view of Bade et al. (US 6,778,837).

Re claims 3, 4, 10, 11 and 15, Chan et al. disclose a system and a method for providing personalization solutions for smart cards (identity documents). The system includes, among other things, a card issuer system, a card processing system and a card personalization system. All of the systems that further include personal computing means are connected via a network such as the Internet, dedicated line, a cable or a satellite communication system.

However, Chan et al. do not disclose a personal computing means including a global positioning system receiver for mobile communications transceiver.

Bade et al. disclose a system and method for providing access to mobile devices based on positional data. The portable/wireless device can be any suitable mobile electronic device, such as a notebook (personal computer), personal data assistant (PDA), cellular/cordless telephone, or

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similar smaller device. The mobile device 104 accepts user input 208 from a user 102 and can be interconnected to a network environment 210, preferably wirelessly via a cellular or wireless modem networking system. The network environment 210 can be any suitable network, such as a local or intranet system or a wide area network like the Internet. The portable/wireless device comprises a receiver module for receiving positional information, which is subsequently processed to determine a proper authentication of a user.

In view of Bade et al., it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a portable/mobile device with an authentication system based on positional information of a user in addition to the smart card personalization system of Chan et al. due to the fact that more personal identification data card can be programmed on a smart card with a minimum geographical limitation of where the personalization system is located. As long as the positional data is within defined parameters, the user/operator of the personalization system, the operator is not limited to a specific location to perform the personalization process of an identification document.

Re claim 16, Chan et al. in view of Bade disclose the method as recited in rejected claim 15 stated above, wherein the enable request comprises information on the current geographic location of the personalization machine (portable/wireless device 104 of Bade et al.), and further comprising checking the information in the enable request against information stored at the controlling authority (Fig. 2 and 3).

Re claim 17, Chan et al. in view of Bade disclose the method as recited in rejected claim 16 stated above, further comprising sending an enable signal from the controlling authority to the personalization machine if the enable request information matches the stored information at the

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controlling authority, wherein the enable signal enables operation of the personalization unit so that it can perform a personalization function (col. 3 line 46 - col. 4, line 59).

Re claim 18 Chan et al. in view of Bade disclose the method as recited in rejected claim 15 stated above, further comprising inputting local operator authorization (such as a password) and sending an enable request to the controlling authority for each operation of the personalization unit that requires operator intervention (col. 3, line 46 - col. 4, line 59).

Re claim 19, Chan et al. in view of Bade disclose the method as recited in rejected claim 15 stated above, further comprising inputting data to be personalized by the personalization unit into the personalization machine, sending the data to be personalized to the controlling authority, checking the data to be personalized against stored data at the controlling authority, and if there is a match, sending an authorization signal from the controlling authority to the personalization machine to enable the personalization unit to personalize the data onto the identity document.

7. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US 6,588,673) as modified by Bade et al. (US 6,778,837) as applied to claim 17 above, and further in view of Tushie et al. (US 6,014,748).

The teachings of Chan et al. in view of Bade et al. have been discussed above.

Neither of the references specifically discloses a step of sending a report to a controlling authority after the completion of each personalization action.

Tushie et al. disclose a step of generating a report of the results of on each personalized process. The statistical information about the smart card personalization system would be a valuable tool for auditing of the system and measuring productivity of the system.

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Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have incorporated the step of generating a production report of a smart card personalization process as taught by Tushie et al. into the teachings of Chan et al. in view of Bade et al. for the purpose of maximizing the productivity within the process fabricating a personalized smart card.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Laing et al. (US 5,534,857) disclose a system and a method for secure decentralized personalization of smart cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

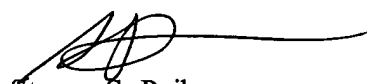
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'SP', with a long horizontal line extending to the right.

Steven S. Paik  
Primary Examiner  
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ssp